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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,646	05/15/2002	Anthony Donnellan	9052-96	9685
20792	7590	10/06/2003	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC			FULTON, CHRISTOPHER W	
PO BOX 37428				
RALEIGH, NC 27627			ART UNIT	PAPER NUMBER
			2859	

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/009,646	DONNELLAN, ANTHONY
Examiner	Art Unit	
Christopher W. Fulton	2859	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 11 August 2003.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-15 and 17-27 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 6 and 25-27 is/are allowed.

6) Claim(s) 1-5,7-15 and 17-23 is/are rejected.

7) Claim(s) 24 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 11 August 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the angle between the two non-parallel substantially flat portions being 60, 45, or 120 degrees as stated in claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9, 21, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is vague and indefinite because the claim does not further limit independent claim 1 since the limitation cited in claim 9 already exists in claim 1.

Claims 21 and 22 are vague and indefinite because the tiling guide is being claimed as being sized to be obscured from view by the tile and the grout. This limitation is indefinite for the following two reasons:

a) The tile is not being claimed and therefore the relative size of the guide to the size of the tile cannot be claimed.

b) Even if the tile were being claimed, as in claim 20, the specific size of the tiles is not claimed and therefore it cannot be determined from the claim what size the guide can be since the tile size cannot be determined from the claim.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 7, 8, 10, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Cable.

The device as claimed is disclosed by Cable comprised of a flexible single elongate member with a surface engaging means 44 securable to the surface, a plurality substantially flat elongate portions 14 at 90 degrees to each other having a tile engaging side and a surface engaging side with the end of the guide provided with a 90 degree marking (the end of the guide) that can be used to cut away tile.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 7, 8, 10, 15, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over CH 579 693 in view of Cable.

The device as claimed is substantially disclosed by CH 579 693 with a surface engaging means 1 securable to the surface, a plurality substantially flat elongate portions 2 at 90 degrees to each other having a tile engaging side that subtends from 2 to 10 degrees and a surface engaging side with the end of the guide provided with a 90 degree marking (the end of the guide) that can be used to cut away tile, but lacks the device being comprised of a single flexible elongate member.

Cable teaches making a tile guide of a single flexible member for strength and storability. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of CH 579 693 out of a single flexible member as taught by Cable for a strong and easily storable device.

8. Claims 1-3, 7, 8, 10, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 617 182 in view of Cable.

The device as claimed is substantially disclosed by EP 617 182 with a surface engaging means 19 securable to the surface, a substantially flat elongate portion 2 having a tile engaging side and a surface engaging side with the end of the guide provided with a 90 degree marking (the end of the guide) that can be used to cut away tile. With respect to claim 13 it would appear as if the cutouts were intended to be located in the surface-engaging means as shown in figure 3 and

not in the elongate portion as shown in figure 8 since the embodiment that bends is shown by figure 3, therefore, EP 617 182 discloses cutout 14 between the surface engaging means 19 so the device can be bent. If the cutouts are intended to be in the elongate member (ridge) then claim 13 would be lacking support in the specification and would be rejected by the art used for claim 4 since that claim is directed to the cutouts being in the ridge or elongate portion, but lacks the device being comprised of a single flexible elongate member.

Cable teaches making a tile guide of a single flexible member for strength and storability. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device of EP 617 182 out of a single flexible member as taught by Cable for a strong and easily storable device.

9. Claims 11, 12, 14, 17-20, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cable.

The device as claimed is disclosed by Cable as stated in the rejection recited above for claims 1-3, 7, 8, 10, and 21, but lacks the securing means being adhesive with a removable protective peal off sheet, the securing means being a roughened bottom portion, and the method of tiling using a mark as a starting point to place the guide. The base reference of Cable discloses securing the guide to the surface, but does not disclose how the securing is done. It is old and well known to use adhesive with a peal off backing to secure guides to a surface. It is also old and well known to roughen the back of guide to prevent slipping. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either of these old and well known means to secure the guide of Cable since the guide will remain in the

tile. It is old and well known to use a guide mark of the surface to be tiled as a starting point in tiling. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a guide mark to locate the guide of Cable at a desired location to insure the tiles are installed at the desired orientation.

10. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cable in view of Kingston et al.

The device as claimed is disclosed by Cable as stated in the rejection recited above for claims 1-3, 7, 8, 10, and 21, but lacks the elongate ridge member having cutouts therein.

Kingston et al teaches using guide with elongated ridge members having cutouts (castellated) to provide adjustment between the various members. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use cutouts in Cable as taught by Kingston et al to make the guide more versatile by make the various members adjustable relative to each other.

#### *Allowable Subject Matter*

11. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 6 and 25-27 are allowed.

#### *Response to Arguments*

13. Applicant's arguments filed August 11, 2003 have been fully considered but they are not persuasive. The replacement sheet for figures 5-7 has been approved, however, the objection to

the drawings is repeated because the claimed subject matter of claim 8 is still not shown. With respect to the addition of the limitation of the device being pliable so that it can be rolled into a spiral for storage. This limitation is met by the Cable reference at column 2 lines 51-62 as being flexible.

*Conclusion*

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher W. Fulton whose telephone number is (703) 308-3389. The examiner can normally be reached on M,T,Th,F 6:00-4:30.

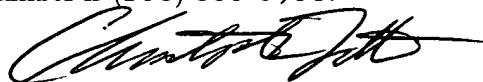
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Christopher W. Fulton  
Primary Examiner  
Art Unit 2859

CWF  
October 1, 2003